

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-7, 9-19, 21-25, and 28-34 are pending in this application. Claims 1, 13, 28, and 31 are amended and new Claims 33 and 34 are added by the present amendment. As amended Claims 1, 13, 28, and 31 and new Claims 33 and 34 are supported at least by Figure 4, no new matter is added.

In the outstanding Official Action, Claims 1-7, 9-12, 28, 29, 31, and 32 were rejected under 35 U.S.C. §103(a) as unpatentable over Klein et al. (U.S. Patent No. 5,726,885, herein “Klein”) in view of Steinberg et al. (U.S. Patent No. 6,628,325, herein “Steinberg”); and Claims 13-19, 21-25, and 30 were rejected under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg and further in view of Shiota et al. (U.S. Patent No. 6,657,660, herein “Shiota”).

With regard to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg, that rejection is respectfully traversed.

Claim 1 recites in part:

the client terminal comprises an image transmission method designating unit configured to designate, *at the time of reservation, server terminal information related to a method of transmission of input image data once the information device is returned and a transmission address, ...*, and
the server terminal transmits the input image data to the transmission address based on the method of transmission.

The outstanding Office Action conceded that there is no teaching or suggestion in Klein for “an image transmission method designating unit” as recited in Claim 1.¹ The outstanding Office Action cited Steinberg as describing “an image transmission designation

¹See the outstanding Office Action at page 3, lines 15-17.

unit configured to transmit an input image.”² However, Steinberg at most describes a digital camera 10 that can receive commands regarding data transmission. As there is no teaching or suggestion in Steinberg regarding making a reservation, Steinberg cannot teach or suggest a device configured to designate, *at the time of reservation*, a method of transmission of data *or* a transmission address. Thus, neither Klein nor Steinberg teach or suggest “an image transmission method designating unit *configured to designate, at the time of reservation*, server terminal information related to a method of transmission of input image data once the information device is returned *and* a transmission address” as recited in amended Claim 1.

The outstanding Office Action further asserted that “It appears that applicant is trying to identify the system by what it does or by a property or characteristic it has rather than by what it is. For example, the applicant states that the server terminal transmits the input image data to a user of the information device based on the method of transmission. The Examiner asserts that the prior art apparatus must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has a reason to believe that the functional limitation can be performed by the prior art structure, the burden is on the applicant to prove otherwise. In this case, the Examiner has a reason to believe that the prior art structure can transmit input image data.”³ No authority of any kind was cited to support this reasoning, which is clearly contrary to well settled case law.

Initially, it is respectfully noted that the invention recited in Claim 1 includes a server terminal that is configured to transmit the input image data to a transmission address based on a method of transmission which are both designated by the image transmission method designating unit *at the time of reservation*. Thus, as noted above, as neither Klein nor Steinberg teach or suggest any apparatus configured to designate at the time of a reservation a

²See the outstanding Office Action at page 3, lines 19-20.

³The outstanding Official Action at page 4, lines 11-19.

method of transmission *or* a transmission address, the proposed combination of Klein in view of Steinberg does not teach or suggest each and every claim element of Claim 1.

With regard to the conclusion “The Examiner asserts that the prior art apparatus must be distinguished from the prior art in terms of structure rather than function alone,” this statement is clearly contrary to *In re Schreiber*, which holds that while features of an apparatus may be recited either structurally *or functionally*, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In the present case, Claim 1 recites a structural element, an image transmission method designating unit, whose feature is defined functionally, in accordance with *In re Schreiber*.

With respect to the statement “If the Examiner has a reason to believe that the functional limitation can be performed by the prior art structure, the burden is on the applicant to prove otherwise,” it is again noted that this statement is contrary to *In re Schreiber* and *In re Royka*, which holds that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Thus, only a teaching or suggestion in a cited reference can serve to render an element obvious, not “a reason to believe that the functional limitation can be performed by the prior art structure.” Moreover, no authority has been cited to support the assertion that “the burden is on the applicant to prove otherwise” either.

Finally, with regard to the statement “In this case, the Examiner has a reason to believe that the prior art structure can transmit input image data,” it is respectfully noted that the applicant does not dispute that Steinberg can transmit input image data. However, Steinberg does not teach or suggest that a server terminal transmits the input image data based on the method of transmission to a transmission address designated by an image transmission method designating unit *at the time of reservation*. To the extent that the

outstanding Office Action ignores these additional features of the claimed invention in making the present rejection, this is contrary to *In re Wilson*, which holds that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Consequently, as Klein and Steinberg do not teach or suggest each and every element of amended Claim 1, amended Claim 1 (and Claims 2-7, 9-12, and 32 dependent therefrom) is patentable over Klein in view of Steinberg.

As independent Claims 28 and 31 recite similar elements to Claim 1, Claims 28 and 31 (and Claims 29 and 30 dependent therefrom) are patentable over Klein and Steinberg for at least the reasons discussed above with respect to Claim 1.

With regard to the rejection of Claim 13 under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg and further in view of Shiota, that rejection is respectfully traversed.

Claim 13 recites in part:

the client terminal comprises an image transmission method designating unit ***configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data once the information device is returned and a transmission address, ...*** and
the server terminal transmits the input image data to the transmission address based on the method of transmission.

The outstanding Office Action conceded that there is no teaching or suggestion in Klein for “an image transmission method designating unit” as recited in Claim 13. The outstanding Office Action cited Steinberg as describing “an image transmission designation unit configured to transmit an input image.”⁴ However, as noted above, the cited portions of Steinberg at most describe a digital camera 10 that can receive commands regarding data transmission. There is no teaching or suggestion in Steinberg regarding making a

⁴See the outstanding Office Action at page 12, lines 1-4.

reservation. Thus, Steinberg cannot teach or suggest a device configured to designate, *at the time of reservation*, a method of transmission of data *or* a transmission address.

Consequently, it is respectfully submitted that Steinberg also does not teach or suggest “an image transmission method designating unit *configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data once the information device is returned and a transmission address*” as recited in amended Claim 13. Further, it is respectfully submitted that Shiota does not teach or suggest this element either.

The outstanding Office Action again makes unsupported assertions⁵ similar to those quoted above, which are submitted to be contrary to well settled case law, as noted above. Consequently, as Klein, Steinberg, and Shiota do not teach or suggest each and every element of amended Claim 13, amended Claim 13 (and Claims 14-19 and 21-25 dependent therefrom) is patentable over Klein in view of Steinberg and further in view of Shiota.

New Claims 33 and 34 are supported at least by Figure 4. It is respectfully submitted that new Claims 33 and 34 recite subject matter that further defines over the cited references, as well as being dependent from allowable Claim 1. New Claim 33 recites in part “said image transmission method designating unit is configured to designate, at the time of reservation, reservation start information and reservation return information.” New Claim 34 recites in part “said image transmission method designating unit is configured to designate, at the time of reservation, reservation start information including a date and time a reservation will start and reservation return information including a date and time the reservation will end.” It is respectfully submitted that none of the cited references teach or suggest a unit configured to additionally designate, *at the time of reservation*, reservation start information and reservation return information as recited in new Claim 33, much less reservation start

⁵See the outstanding Office Action at page 13, lines 5-13.

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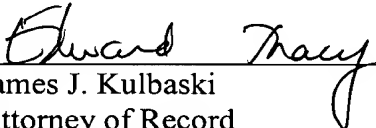
information including a date and time a reservation will start and reservation return
information including a date and time the reservation will end as recited in new Claim 34.

Consequently, it is respectfully submitted that new Claims 33 and 34 further define over the
cited references.

Accordingly, no further issues are believed to be outstanding and the present
application is believed to be in condition for formal allowance. An early and favorable action
to that effect is respectfully requested.

Respectfully submitted,

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